

REMARKS

Reconsideration and withdrawal of the rejections set forth in the Office action dated May 14, 2003 are respectfully requested. Applicants petition the Commissioner for a 2-month extension of time. A separate petition accompanies this amendment.

I. Amendments

A. In the specification:

The specification is amended in accord with 37 C.F.R. §1.821(d) to make reference to sequences by use of the sequence identifier preceded by "SEQ ID NO:".

The specification is further amended to clarify the definition of the rice Gns9 promoter as a beta-glucanase promoter. The specification is amended to additionally recite a beta-glucanase promoter. Support for these amendments can be found in original claim 1.

B. In the claims:

Claim 1 is amended to clarify the steps in section (b) of the method.

Claim 6 is amended to correct an obvious typographical error.

By these amendments, no new subject matter has been added.

II. Priority

The Examiner asserts that the claims drawn to wheat transformation would have been afforded an effective filing date of 17 August 2001 as "the parent application was silent with respect to detailed methods for wheat transformation." Applicants submit that the invention described in the parent application clearly contemplated transformation of wheat. Applicants respectfully direct the Examiner to the parent application at Col. 9, lines 26-26 where inducible wheat promoters are described; Col. 10, lines 46-45 where plants of the invention are described as monocots of the grass family, specifically wheat at lines 47-48; and Col. 11, lines 32-34 and lines 60-66, and Col. 12, lines 5-7 and 12-14, among others, where methods of transforming wheat that are known in the literature are described. Nothing more than objective enablement is required, and therefore it is

irrelevant whether this teaching is provided through broad terminology or illustrative examples (*In re Wright*, 999 F.2d 1557, 27 USPQ2d 1510 (Fed Cir. 1993). Accordingly, Applicants submit that the patent application provides priority for transformation of wheat.

III. Objections

The specification and claims were objected to for an alleged inconsistency in the definition of the rice Gns9 promoter, SEQ ID NO:1. The specification was further objected to under 37 C.F.R. §1.821(d) for omission of sequence identifiers. Claim 6 was objected to for a typographical error.

The specification is amended to clarify the definition of the rice Gns9 promoter as a rice beta-glucanase promoter.

The specification is further amended in accord with 37 C.F.R. §1.821(d) to add sequence identifiers.

Claim 6 is amended in accord with the Examiner's kind suggestion to correct the typographical error.

IV. Obviousness-Type Double Patenting Rejection

Claims 1-6 were rejected under the judicially created doctrine of obviousness-type double patenting as being directed to an invention not patentably distinct from claims 1-5 and 8-9 of co-owned U.S. Patent No. 6,284,956.

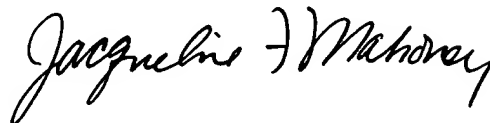
A Terminal Disclaimer prepared in accordance with 37 C.F.R. §1.321(b) and (c) is enclosed. The signed Terminal Disclaimer obviates the above obviousness-type double patenting rejection.

CONCLUSION

In view of the foregoing, Applicants submit that the claims pending in the application are in condition for Allowance. A Notice of Allowance is therefore respectfully requested.

The Examiner is invited to contact Applicants' representative at (650) 838-4410 if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted,

A handwritten signature in black ink, reading "Jacqueline F. Mahoney". The signature is written in a cursive, flowing style.

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